

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Eugenio A. Cefali  
Application No. : 08/962,027 Confirmation No.:  
Filed : October 31, 1997  
For : INTERMEDIATE RELEASE NICOTINIC ACID  
COMPOSITIONS FOR TREATING HYPERLIPIDEMIA  
Group : 1615  
Examiner : Robert M. Joynes

**RECEIVED**

JAN 16 2003

OFFICE OF PETITIONS

Hon. Commissioner for Patents  
P.O. Box 2327  
Arlington, Virginia 22202

DECLARATION OF PETER J. MANSO  
IN SUPPORT OF PETITION TO WITHDRAW HOLDING OF ABANDONMENT  
PURSUANT TO 37 C.F.R. § 1.181(a) OR, IN THE ALTERNATIVE, TO  
REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION  
PURSUANT TO 37 C.F.R. § 1.137(b)

Sir:

I, PETER J. MANSO, declare that:

1. I am of counsel to the law firm of Edwards & Angell, LLP. Until recently, I was the principal attorney of record in the above-identified application and am now associate attorney of record. I make this declaration in support of applicant's Petition to Withdraw Holding of Abandonment Pursuant to 37 C.F.R. § 1.181(a) or, in the alternative, to

Revive An Unintentionally Abandoned Application Pursuant to 37 C.F.R. § 1.137(b), filed concurrently herewith.

2. I have reviewed the July 6, 2001 Notice of Abandonment, the September 24, 2001 Petition to Revive For Failure To Timely Pay Issue Fee Or File Reply Under 35 U.S.C. § 151 and 37 C.F.R. 1.137(b) and its accompanying Issue Fee Transmittal in the above-identified application.

3. As explained in the September 24, 2001 Petition to Revive, the above-identified application became abandoned for failure to timely file the issue fee on or before June 4, 2001. The failure to file the issue fee was unintentional, and resulted from the fact that the Notice of Allowance had been mailed to my former law firm, Akerman, Senterfitt, Eidson, rather than my current law firm, Edwards & Angell, LLP, which I joined after March 2, 2001. Due to my transition between law firms, the March 2, 2001 Notice of Allowance was inadvertently misplaced.

4. As stated in the September 24, 2001 Petition to Revive, the entire delay in filing a reply to the July 6, 2001 Notice of Abandonment, from the due date for the reply until the filing of that petition, was unintentional.

5. I have also reviewed the October 16, 2001 Decision dismissing the September 24, 2001 Petition to Revive

("October 16, 2001 Decision") in the above-identified application for failure to include corrected formal drawings. The failure to include those drawings was unintentional. I recall that I prepared the September 24, 2001 Petition to Revive solely by reference to the July 6, 2001 Notice of Abandonment, which designated the reason for the abandonment as non-receipt of the issue fee alone, rather in combination with failure to timely file new formal drawings.

6. On April 16, 2002, I timely filed a response to the October 16, 2001 Decision. Exhibit A to this declaration includes true copies of the documents I filed in connection with that response. Those documents include: a Transmittal Letter, a Renewed Petition Under 37 C.F.R. § 1.137(b) enclosing Formal Drawings (Figures 1-5) and a return postcard receipt. In the Transmittal Letter for my April 16, 2002 filing, I authorized the Commissioner to charge payment of any extension of time fees (in this case, a four-month extension of time fee), as well as the issue fee, to Edwards & Angell's Deposit Account. As indicated on the face of the Transmittal Letter and the Renewed Petition, I filed all of those documents in the United States Patent and Trademark Office via certificate of mailing procedure pursuant to 37 C.F.R. § 1.8(a)(1)(i)(A) on

April 16, 2002. I specifically recall depositing those documents in first class mail on April 16, 2002.

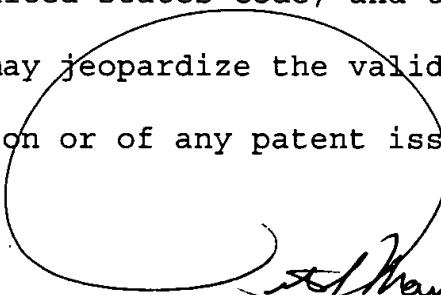
7. My file copy of the above-identified application does not contain the postcard receipt which should have been returned to me from the United States Patent and Trademark Office bearing a date-stamp. Nor does my file contain, nor can I recall receiving, any further official correspondence from the United States Patent and Trademark Office regarding the above-identified application.

8. I understand that Karen J. Messick, in-house Intellectual Property Counsel for Kos Pharmaceuticals, Inc., was informed by Examiner Cheryl Gibson of the Office of Petitions at the United States Patent and Trademark Office on January 7, 2003, that the Petitions Office had no record of receiving the Transmittal Letter, Renewed Petition and Formal Drawings which I filed on April 16, 2002 and that the Patent Office records listed the status of the above-identified application as abandoned.

9. I believe that the July 6, 2001 holding of abandonment of the above-identified application should be withdrawn because a proper response to the October 16, 2001 Decision was timely filed on April 16, 2002. In the alternative, should the concurrently-filed petition be treated

as a Petition to Revive, I hereby state my belief that, based on all of the foregoing circumstances, the entire delay to date in filing the accompanying petition, the issue fee and corrected formal drawings in the above-identified application was unintentional.

10. The undersigned further declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or of any patent issuing thereon.



Peter J. Manso (Reg. No. 32,264)  
c/o Edwards & Angell, LLP  
350 East Las Olas Boulevard  
Suite 1150  
Ft. Lauderdale, Florida 33301  
Tel.: (954) 727-2600

Signed this 9th day  
of January, 2003,  
at Ft. Lauderdale, FL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**CERTIFICATE OF MAILING - 37 C.F.R. § 1.8**

I hereby certify that this paper or fee is being deposited with the U.S. Postal Service with sufficient pre-paid postage as First Class Mail, on April 16, 2001, and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

  
Peter J. Manso, Reg. No. 32,264

4-16-2002  
April 16, 2002  
Deposit Date

RECEIVED

In re Application of: Eugenio Cefali JAN 16 2003  
Serial No.: 08/962,027  
Filing Date: October 31, 1997 OFFICE OF PETITIONS  
Group Art Unit: 1615  
Examiner: R. Joynes  
Title: **INTERMEDIATE RELEASE NICOTINIC ACID  
COMPOSITIONS FOR TREATING HYPERLIPIDEMIA**

Assistant Commissioner for Patents  
Washington, D.C. 20231

April 16, 2002

Sir:

**TRANSMITTAL**

Transmitted herewith are the following documents and fee:

1. Renewed Petition under 37 C.F.R. § 1.137(b);
2. Formal Drawings - Figs. 1-5; and
2. Return Post Card.

Please charge to Deposit Account No. \_\_\_\_\_ with the fee in the amount of \_\_\_\_\_. Please charge any deficiency or credit of overpayment to Deposit Account No. \_\_\_\_\_. This sheet is attached in duplicate.

A check in the amount of \_\_\_\_\_ is attached for payment of the Preliminary Examination Fee and Handling Fee. Please charge any deficiency or credit any overpayment to Deposit Account No. \_\_\_\_\_.

The Commissioner is hereby authorized to charge payment of the following fees, including any and all filing fees, recordation fees, and extension of time fees, concerning this communication or other communications involving this application for U.S. patent, or to credit any overpayment to Deposit Account No. 04-1105/38292.00023. This sheet is attached in duplicate.

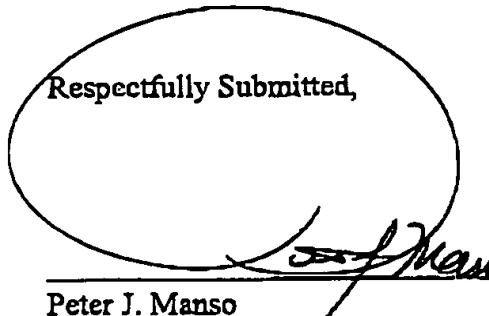
Any additional filing fees required under 37 CFR § 1.16 including fees for presentation of extra claims.

Any additional patent application processing fees under 37 CFR § 1.17.

Any fees for filing the Petition filed on Sept. 28, 2001 or Renewed Petition under 37 C.F.R. § 1.137(b) and 37 C.F.R. § 1.17(m).

Issue Fee under 37 CFR § 1.18.

Respectfully Submitted,

  
Peter J. Manso  
Reg. No. 32,264

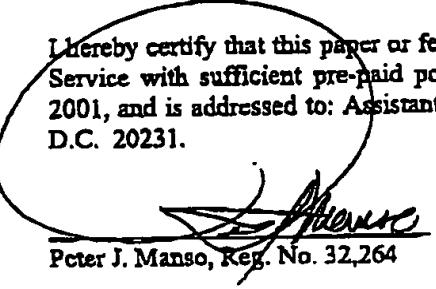
Date: April 16, 2002

Edwards & Angell, LLP  
600 Corporate Drive  
Suite 514  
Ft. Lauderdale, FL 33334  
(954) 491-8050 (Office No.)  
(954) 351-7175 (Fax No.)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF MAILING - 37 C.F.R. § 1.8

I hereby certify that this paper or fee is being deposited with the U.S. Postal Service with sufficient pre-paid postage as First Class Mail, on April 16, 2001, and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

  
Peter J. Manso, Reg. No. 32,264

4-16-2002  
April 16, 2002  
Deposit Date

RECEIVED

JAN 16 2003

OFFICE OF PETITIONS

In re Application of: Eugenio Cefali  
Serial No.: 08/962,027  
Filing Date: October 31, 1997  
Group Art Unit: 1615  
Examiner: R. Joynes  
Title: **INTERMEDIATE RELEASE NICOTINIC ACID  
COMPOSITIONS FOR TREATING HYPERLIPIDEMIA**

Assistant Commissioner for Patents  
Washington, D.C. 20231

April 16, 2002

Sir:

**RENEWED PETITION UNDER 37 C.F.R. § 1.137(B)**

In response to the decision to Dismiss the Petition submitted in the above-identified application under 37 C.F.R. 1.137(b), filed September 28, 2001, a Renewed Petition under 37 C.F.R. § 1.137(b) is respectfully submitted.

To over come the decision to Dismiss, formal drawings, i.e., Figs. 1-5, responsive to the Office Action or Notice are submitted herewith.

It is further respectfully submitted that, even though authorization was provided in the Petition filed on September 28, 2001 to charge the issue fee and the petition fee to Deposit Account No. 04-1105, authorization is again provided to charge the issue fee and the petition fee to Deposit Account No. 04-1105.

If the Petitions Office should have any questions or require additional information or clarification, Applicant requests that the Petitions Office contact the undersigned attorney of record herein, Peter J. Manso, at the phone numbers and address noted below.

Respectfully Submitted,

  
Peter J. Manso  
Reg. No. 32,264

Date: April 16, 2001

Edwards & Angell, LLP  
600 Corporate Drive  
Suite 514  
Ft. Lauderdale, FL 33334  
(954) 491-8050 (Office No.)  
(954) 351-7175 (Fax No.)

ATTORNEY DOCKET NO.: \_\_\_\_\_

PATENT

The U.S. Patent and Trademark Office date stamp sets forth the receipt date (or both the receipt date and the Serial Number) of the patent or trademark or service mark application identified as follows:

Applicant: Eugenio Catali

U.S. Serial No. 06/826,207 Filing Date: 10/31/87 Group Art Unit: 1615

Title: Intermediate Release Nitrolic Acid Cognac Liqueur

Mark: For Treating Hyperglycemia

|  |  |
|--|--|
| <input type="checkbox"/> Transmittal Letter  | <input type="checkbox"/> Combined Declaration and Power of Attorney  |
| <input type="checkbox"/> Assignment & Check <u>5</u>   | <input type="checkbox"/> Executed _____ Unexecuted _____             |
| <input type="checkbox"/> Amendment/Response _____ pgs.                                       | <input type="checkbox"/> Status Inquiry                              |
| <input type="checkbox"/> Response to Notice to File Missing Parts                            | <input type="checkbox"/> Declaration Under Rule 131 or 132           |
| <input type="checkbox"/> Petition for Ext. of Time (____) Months                             | <input type="checkbox"/> Request Certificate of Correction           |
| <input type="checkbox"/> Maintenance Fee   | <input type="checkbox"/> Notice of Appeal                            |
| <input type="checkbox"/> Issue Fee Transmittal   | <input type="checkbox"/> Appeal Brief (3 Copies) _____ pgs.          |
| <input type="checkbox"/> Request Patent Copies   | <input type="checkbox"/> Certificate of Express Mail 37 CFR 1.10     |
| <input checked="" type="checkbox"/> Drawings <u>4</u> Sheets Formal <u>1</u> Sheets Informal | <input type="checkbox"/> Express Mail No. _____                      |
| <input type="checkbox"/> Information Disclosure Statement                                    | <input type="checkbox"/> Certificate of Mailing Under 37 CFR 1.8(a)  |
| <input type="checkbox"/> PTO Form 1449, _____ References                                     | <input type="checkbox"/> Trademark Application _____ pgs.            |
| <input type="checkbox"/> Patent Application-Specification _____ pgs.                         | <input type="checkbox"/> Trademark Specimen _____ pgs.               |
| Claims _____ nos. Abstract _____ pgs.  | <input type="checkbox"/> Trademark Declaration, §§ 8 & 15            |
| <input type="checkbox"/> Check <u>5</u>  | <input checked="" type="checkbox"/> Other <u>Renewal Application</u> |
| <input type="checkbox"/> Small Entity Statement  | <u>Serial 13-568-1325</u>  |

Att'y/Sec: PSM Clients: KOS  
Initials: PSM Matter Name: KOS Date: 4-16-2002

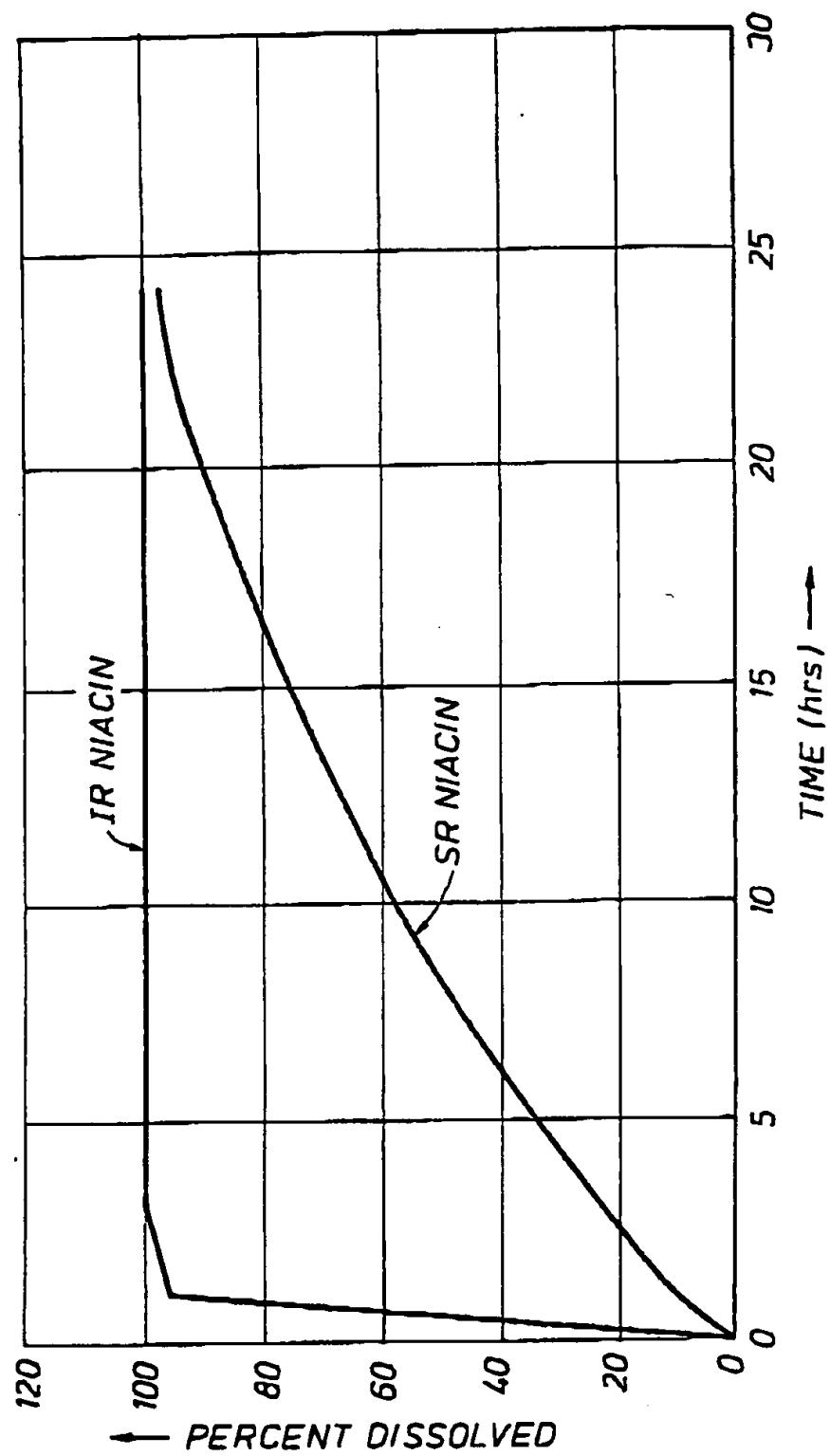


**Edwards & Angell, LLP  
600 Corporate Drive  
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FIG. 1



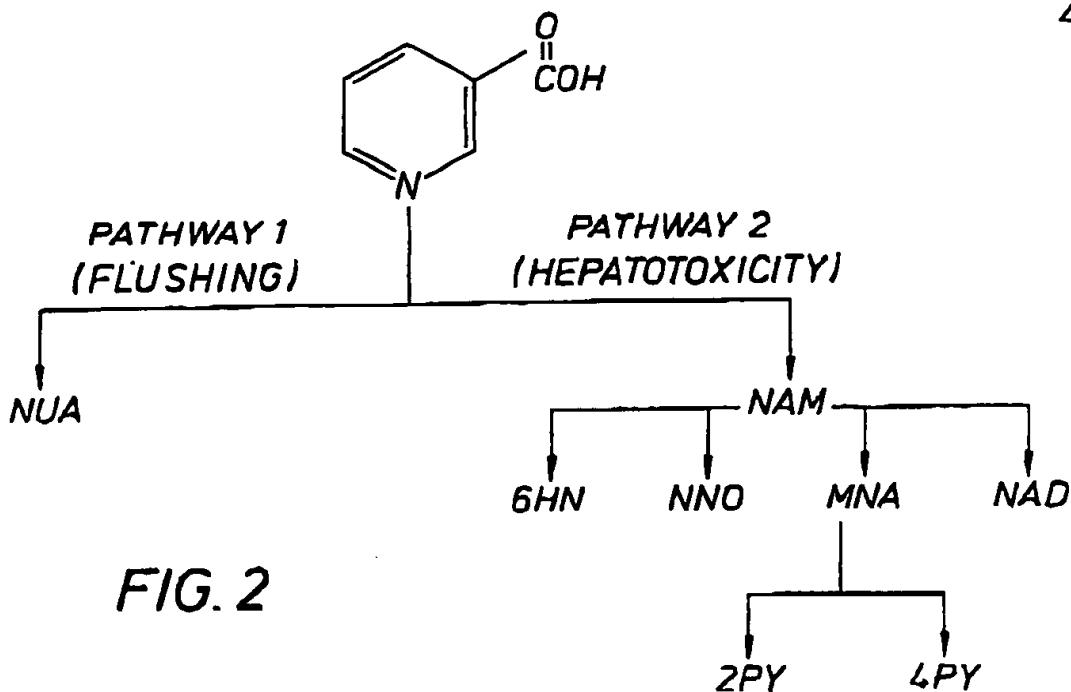
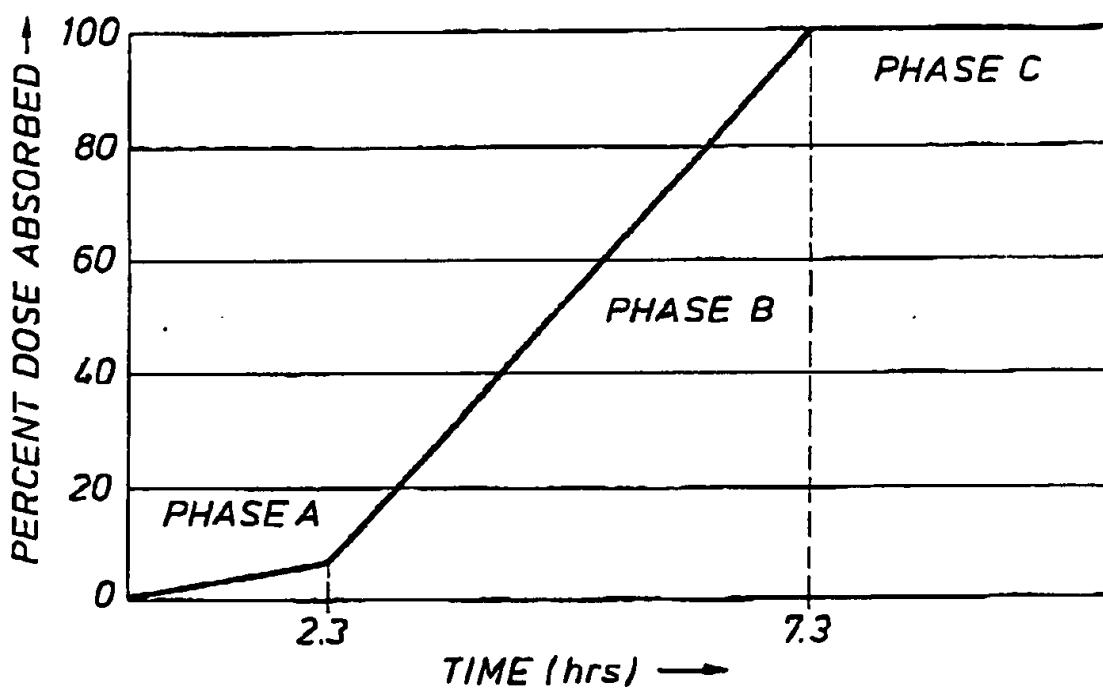


FIG. 2

FIG. 3



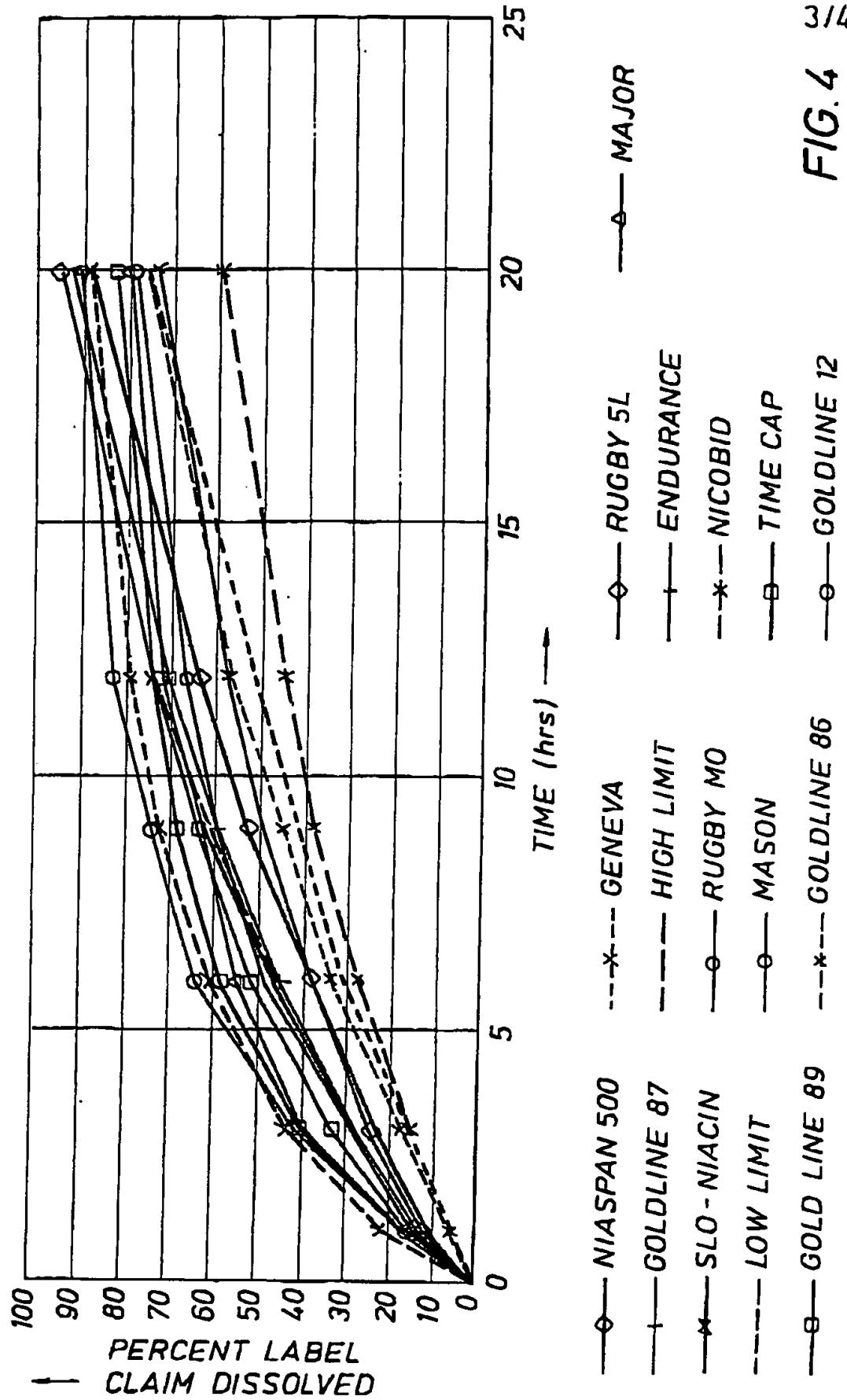
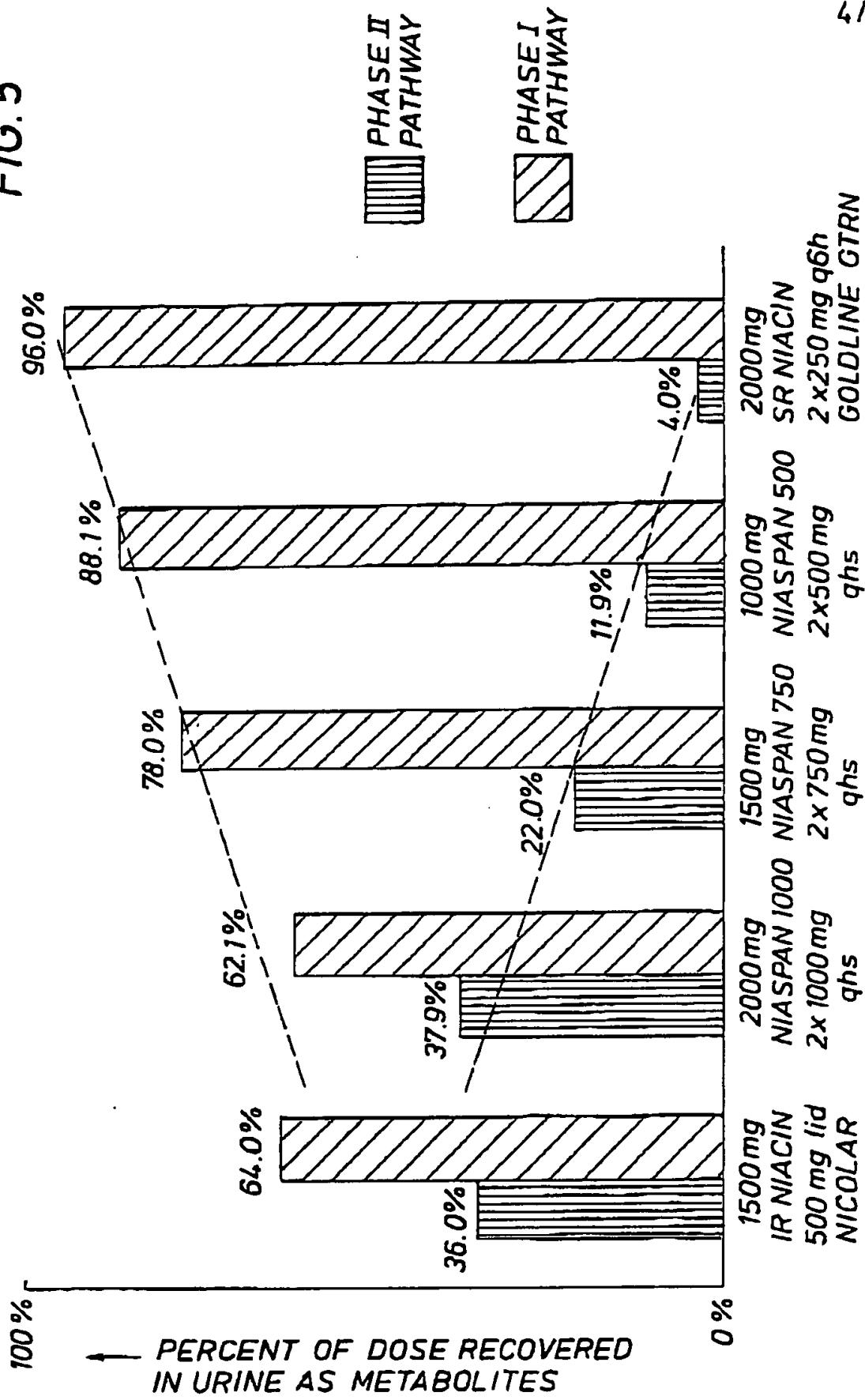


FIG. 4 3/4

FIG. 5





UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
Washington, DC 20231  
[www.USPTO.gov](http://www.USPTO.gov)

Paper No. 18

Peter J. Manso  
Edwards & Angell, L.P.  
600 Corporate Drive  
Suite 514  
Fort Lauderdale, FL 33334

**COPY MAILED**

OCT 16 2001

**OFFICE OF PETITIONS**

In re Application of  
Eugenio A. Cefali  
Application No. 08/962,027  
Filed: October 31, 1997  
Attorney Docket No. 32892.23

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 28, 2001, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition

pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lack(s) item(s) (1).

In view of the authorization contained in the petition to charge the necessary fees due, the \$620.00 issue fee and \$620.00 petition fee will be charged to Deposit Account No. 04-1105. However, there is no indication that formal drawings as required by the Notice of Allowability of March 2, 2001 have been submitted. Accordingly, this application cannot be revived until formal drawings have been submitted.

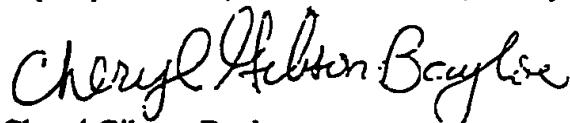
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By facsimile: (703) 308-6916  
Attn: Office of Petitions

By hand: Office of Petitions  
2201 South Clark Place  
Crystal Plaza 4, Suite 3C23  
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111, or in her absence, Sherry Brinkley at (703)305-9220.



Cheryl Gibson-Baylor  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy



Sherry Brinkley  
Petitions Examiner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Eugenio A. Cefali  
Application No. : 08/962,027 Confirmation No.:  
Filed : October 31, 1997  
For : INTERMEDIATE RELEASE NICOTINIC ACID  
COMPOSITIONS FOR TREATING  
HYPERLIPIDEMIA  
Group Art Unit : 1615 **RECEIVED**  
Examiner : Robert M. Joynes **JAN 16 2003**  
**OFFICE OF PETITIONS**

Hon. Commissioner for Patents  
P.O. Box 2327  
Arlington, Virginia 22202

DECLARATION OF KAREN J. MESSICK IN SUPPORT OF PETITION TO  
WITHDRAW HOLDING OF ABANDONMENT PURSUANT TO 37 C.F.R.  
§ 1.181(a) OR, IN THE ALTERNATIVE, TO REVIVE  
UNINTENTIONALLY ABANDONED APPLICATION  
PURSUANT TO 37 C.F.R. § 1.137(b)

Sir:

I, KAREN J. MESSICK, declare that:

1. I am the Intellectual Property Counsel for Kos  
Pharmaceuticals, Inc. ("Kos"), the assignee of the above-  
identified patent application. I have held this position since  
November 5, 2001, when I joined the company. I am the  
principal attorney of record in the above-identified  
application, by virtue of a Power of Attorney and Re-

Designation of Principal Attorney of Record as Associate Attorney of Record effective November 20, 2002. I make this declaration in support of applicant's Petition to Withdraw Holding of Abandonment Pursuant to 37 C.F.R. § 1.181(a) or, in the alternative, to Revive Unintentionally Abandoned Application Pursuant to 37 C.F.R. § 1.137(b), filed concurrently herewith.

2. Prior to the time I began working at Kos, all of its patent prosecution matters were exclusively handled by outside patent counsel. Peter J. Manso, the prior principal attorney of record and current associate attorney of record in the above-identified application, was the outside patent counsel responsible for prosecution of those Kos patent prosecution matters relating to nicotinic acid, including the above-identified patent application.

3. On October 2, 2002, pursuant to my request, a representative from Cantwell & Paxton filed a Power to Inspect and Make Copies in the above-identified application, in order to obtain a complete copy of the official file wrapper of the application. I requested the inspection in order to verify whether Kos' in-house file for the application was complete. At that time, Kos' in-house file for the application did not contain the July 6, 2001 Notice of Abandonment, or any paper dated subsequently.

4. I received a copy of the official file wrapper from Cantwell & Paxton on or after October 16, 2002. In reviewing the official file wrapper, I first became aware of the July 6, 2001 Notice of Abandonment, the September 24, 2001 Petition to Revive for Failure to Timely Pay Issue Fee or File Reply Under 35 U.S.C. § 151 and 37 C.F.R. 1.137(b) and its accompanying Issue Fee Transmittal and the October 16, 2001 Decision dismissing the September 24, 2001 Petition to Revive ("October 16, 2001 Decision") in the above-identified application.

5. After reviewing the official file wrapper for the above-identified application and first learning of the abandonment, I contacted Mr. Manso to discuss it. Mr. Manso informed me that he was unaware that the application was abandoned. In a follow-up discussion, Mr. Manso informed me that he had filed a response to the October 16, 2001 Decision that included the formal drawings and that he recalled filing that response on April 16, 2002 by first class certificate of mail procedure. Mr. Manso subsequently forwarded a copy of that response to me.

6. As set forth in the October 16, 2001 Decision, the September 24, 2001 Petition to Revive was dismissed for failure to include corrected formal drawings. On January 7, 2003, Mr. Manso informed me that the failure to include those

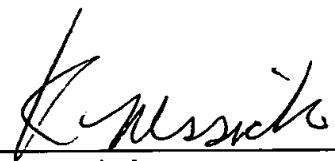
drawings was unintentional. More particularly, Mr. Manso explained that he prepared the September 24, 2001 Petition to Revive based on the July 6, 2001 Notice of Abandonment, which listed the reason for abandonment as non-receipt of the issue fee and did not refer to any failure to file formal drawings.

7. On January 7, 2003, I spoke with Examiner Cheryl Gibson of the Office of Petitions at the United States Patent and Trademark Office. Examiner Gibson informed me that the Petitions Office had no record of receiving the April 16, 2002 response and that the Patent Office records listed the status of the above-identified application as abandoned.

8. I believe that the July 6, 2001 holding of abandonment of the above-identified application should be withdrawn, based on my understanding that a response to the October 16, 2001 Decision was timely filed on April 16, 2002. Alternatively, should the petition filed concurrently herewith be treated as a Petition to Revive, I declare that, based on the foregoing circumstances, the entire delay to date in filing the accompanying petition, the issue fee and corrected formal drawings in the above-identified application was unintentional.

10. The undersigned further declares that all statements made herein of her own knowledge are true and that all statement made on information and belief are believed to be true; and further that these statements were made with the

knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or of any patent issuing thereon.



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Karen J. Messick  
Registration No. 46,256  
C/O Kos Pharmaceuticals, Inc.  
1001 Brickell Bay Drive  
25th Floor  
Miami, Florida 33131  
Tel.: (305) 523-3643

Signed this 15 day  
of January, 2003,  
at Miami, Florida 33131